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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/687,740      | 10/20/2003  | Takeshi Fujino       | 107348-00376        | 9259             |

4372 7590 09/23/2005

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EXAMINER

STADLER, REBECCA M

ART UNIT PAPER NUMBER

1754

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/687,740  | <b>Applicant(s)</b><br>FUJINO, TAKESHI |  |
|                              | <b>Examiner</b><br>Rebecca M. Stadler | <b>Art Unit</b><br>1754                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps. See MPEP § 2172.01. The omitted steps are: the activation step in claim 1. The process as claimed is supposed to produce an activated carbon; however, there is no activation step. Thusly, the process only produces a carbonized product.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a.) In claims 1-3, the phrase "optical anisotropic rate" is unclear. It appears that "optical anisotropic content" is meant.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seo 4,986,893.

Seo, 893 discloses a process for producing pitch, which can be activated. In column 4, lines 37-39, Seo '893 teaches that the pitch shows optical anisotropy. No difference is seen between the claimed optical anisotropy range of 1%-90% and the disclosed optical anisotropy. Further, because the softening point range of Seo '893 (195°C-230°C) is within the claimed softening point range (see claim 3, column 16, lines 14-18), it is expected that the optical anisotropy of the Seo pitch would fall within the claimed range. In the Seo '893 process, the infusibilization heating temperature is about 265°C (see column 9, lines 21-30). About 265°C is read to also include temperatures below 260°C. Although not specifically disclosed, the light content of the pitch is deemed to inherently be greater than 14.5% because claim 3 (see column 16, lines 20-23) teaches that the pitch has a low molecular weight and; therefore, the taught pitch inherently has a high light component content. As to the carbonization temperature, Seo '893 teaches that the heating temperature is 900°C (see column 9, lines 31-36). The Seo process has a temperature-raising speed of 5°C/minute, which is slightly lower than the claimed rate. Seo teaches carbonizing the pitch for 30 minutes, which is a shorter time than the claimed 2 hours. These subtle variations in operating parameters are obvious expedients, which are merely altered in order to provide the best pitch product. Optimization of process parameters through routine experimentation is prima facie evidence of obviousness. See, e.g., In re Boesch, 617 F.2d 272, 205 U.S.P.Q. 215 (CCPA 1980).

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Seo 4,986,893.

As to claims 2 and 3, Seo, 893 discloses a process for producing pitch having optical anisotropy (see column 4, lines 37-39). No difference is seen between the claimed optical anisotropy range of 1%-90% (or less than 50% as in claim 3) and the disclosed optical anisotropy. Further, because the softening point range of Seo '893 (195°C-230°C) is within the claimed softening point range (see claim 3, column 16, lines 14-18), it is expected that the optical anisotropy of the Seo pitch would fall within the claimed range. In the Seo '893 process, the infusibilization heating temperature is about 265°C (see column 9, lines 21-30). About 265°C is read to also include temperatures below 260°C. Although the heating temperature of 265°C is slightly higher than the claimed heating temperature of less than 260°C, it appears that the instantly claimed product by process is the same as that which is claimed. When the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct and not the examiner to show the same process as making. See, e.g., In re Brown, 459 F.2d 531, 173 U.S.P.Q. 685 (CCPA 1972); In re Fessman, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA 1974).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca M. Stadler whose telephone number is 571-272-5956.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

rms



STUART L. HENDRICKSON  
PRIMARY EXAMINER